

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Attorney Docket Number 13311US02

In re Application of:)	
)	
Pasqualino)	
)	Electronically Filed
Serial No.: 10/034,383)	9/3/2008
)	
Filing Date: 12/27/2001)	
)	
Examiner: Yenke)	
)	
Confirmation No.: 8696)	
)	
Art Unit No. 2622)	
)	
)	
)	
)	
)	
)	

REQUEST FOR PRE-APPEAL BRIEF REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This correspondence is filed in response to the Office
Action mailed 6/3/2008.

REMARKS

Claims 1-3, 5-12, 15, 16, 18, 19, 22-24, 26-28 are pending and stand rejected. Assignee respectfully requests pre-appeal brief review of the foregoing rejections.

Claims 1, 12, and 22 were rejected under 35 U.S.C. § 103(a) as being obvious from IBM, Copeland, XP-002202474 and Kim. Claim 1 recites, among other limitations, "concatenating audio data onto said at least one color component". Claim 12 and 22 recite, among other limitations, "concatenating audio data onto said at least one of said color components".

In the previous office action, Examiner indicated that "although IBM/Copeland does not explicitly recite 'audio', the [E]xaminers position is that video/audio are conventionally transmitted/received together for display/listening. The examiner will rely upon applicant's submitted XP-002202474 which evidences the concept of concatenating the audio with video in a DVI link system."

Assignee respectfully traversed and noted that XP-002202474 merely discloses "transmit and receive digital audio data over the same uncompressed digital link as the video data". Even if the foregoing was deemed "concatenating audio with video", the foregoing does not teach "concatenating audio data onto said at least one of said color components". Additionally, the foregoing clearly does not teach "concatenating audio data onto each of said plurality of color components" as recited in claim 28.

Examiner now notes that

...the only mention of concatenating audio onto a color component was disclosed in originally filed claim 25 (now cancelled). There is no disclosure supporting why this was not possible prior to the invention. Thus the examiner's position is that based upon the prior art which discloses transmitted audio and video together (where they are linked), since obviously synchronization between the two is required for proper picture/sound, the linking of audio onto the same stream/signal/component as the video is convention in the art, whereby the linking provides the expected result of linking such data. In the event the applicant disagrees and asserts that linking audio onto video provides unexpected results (in view of the ... KSR v. Teleflex) the examiner requests the applicant to clarify such in order to expedite prosecution.

It is first noted that contrary to Examiner's assertion that "the only mention of concatenating audio onto a color component was disclosed in originally filed claim 25 (now cancelled)", "concatenating audio onto a color component" is shown in the specification, Figure 1, reference 14 "Concatenate Data Bit(S) onto at least one Component", Figure 2, 24, 26, "Split pixel into 8 bit color variables", "Concatenate CRC bit", Figure 3, Data Bit 44 concatenated onto b0...b7, g0...g7, r0...r7, among other places.

Examiner has not provided any reference that explicitly shows "concatenating audio onto a color component". To the extent that Examiner is taking Official Notice, Assignee traverses and requests that Examiner provide a reference. Rather, Examiner concludes that this is the convention because (1) "There is no disclosure supporting why this was not possible prior to the invention"; and (2) the prior art "discloses transmitted audio and video together (where they are linked), since obviously synchronization between the two is required for proper picture/sound, the linking of audio onto the same

stream/signal/component as the video is convention in the art, whereby the linking provides the expected result of linking such data".

The foregoing constitutes legal error. There is no absolutely no legal requirement that Applicant establish "concatenating audio onto a color component" "was not possible prior to the invention". Even if the prior art "discloses transmitted audio and video together (where they are linked)", "synchronization between the two is required for proper picture/sound" and "whereby the linking provides the expected result of linking such data", Examiner has still failed to provide any evidence that "concatenating audio onto a color component" was even known in the prior art. Note that Examiner does not contend, nor provide any basis to conclude that "concatenating audio onto a color component" is inherent. The fact that "synchronization between the two is required" and "linking provides the expected result" still does not establish that "concatenating audio onto a color component", as opposed to transmitting "audio and video together" was known prior to the invention. Therefore, the combination of IBM, Copeland, XP-002202474 and Kim still does not include "concatenating audio onto a color component".

It is also noted that the present case is distinguishable from *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ____ (2007). In *KSR v. Teleflex*, the combination of references explicitly taught every limitation in the claim ("Asano taught everything claim in claim 4 except That additional aspect was revealed in sources such as the '068 patent and the sensors used by Chevrolet"). At issue was

whether the references could be properly combined. In the present case, there is no showing of any kind that "concatenating audio onto a color component" was known in the prior art.

Accordingly, Assignee respectfully requests that the rejections to claims 1, 12, and 22 be withdrawn, as well as to the remaining dependent claims.

CONCLUSION

For at least the foregoing reasons, Assignee respectfully submits that each of the pending claims are allowable and Examiner is respectfully requested to pass this case to issuance. The Commissioner is hereby authorized to charge additional fees or credit overpayments to the deposit account of McAndrews, Held & Malloy, Account No. 13-0017.

Dated: September 3, 2008

Respectfully submitted,



Mirut Dalal
Reg. No. 44,052
Attorney for Applicants

McAndrews, Held & Malloy, Ltd.
500 West Madison Street
Chicago, Illinois 60661

Telephone: (312) 775-8000
Facsimile: (312) 775-8100

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 13311US02	
I hereby certify that this correspondence is being electronically filed with United States Patent and Trademark Office on September 3, 2008 Signature _____ /Mirut P. Dalal/ Typed or printed Name _____ Mirut P. Dalal	Application Number 10/034,383	Filed 12/27/2001	
	First Named Inventor Pasqualino et al.		
	Art Unit 2622	Examiner Yenke	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number 44,052</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
		_____ /Mirut P. Dalal/ Signature	
		_____ Mirut P. Dalal Typed or printed name	
		_____ (312) 775-8063 Telephone number	
		_____ September 3, 2008 Date	
<input type="checkbox"/> *Total of _____ forms are submitted.			